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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,547	10/23/2003	Randy Knight Winjum	13768.468	3629
47973 7590 02/06/2008 WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			EXAMINER NAWAZ, ASAD M	
			ART UNIT 2155	PAPER NUMBER
			MAIL DATE 02/06/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/693,547

Applicant(s)

WINJUM ET AL.

Examiner

Asad M. Nawaz

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/16/07</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the communications filed 10/23/03. Claims 1-21 have been presented for examination.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 8/16/07 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 20-21 are rejected under 35 U.S.C. 101 because they are directed towards a data structure per se or a "connection". The specification, on paragraphs 0023-0024, states that the computer readable medium could comprise a data structure and/or connection. Appropriate corrections are required.

Claims 20-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 20 and 21 embrace or overlap two separate statutory classes of invention set forth in 35 U.S.C. 101 in a single claim. A claim of this type is precluded by the express language of 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in

Art Unit: 2155

the alternative only. Each statutory class of claims must be considered independently on its own merits, see *Ex parte Lyell* (BdPatApp&Int) 17 USPQ2d 1548 *Ex Parte Lyell*.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-21 recites the limitation "the message" in the independent claims. There is insufficient antecedent basis for this limitation in the claim.

7. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the claims indicate that a message is coupled to or decoupled from itself.

8. Claims 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are ambiguously constructed and indeterminate in scope because they purport to claim both a product and method.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2155

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-21 are rejected under 35 U.S.C. 102(b) as being taught by Ogilvie et al (USPAT 6,324,569) hereinafter Ogilvie.

As to claim 1, Ogilvie teaches in a computer system that is network connectable along with one or more other computer systems to a network, a method for determining if an attachment is to be deleted in response to a deletion command requesting deletion of a corresponding electronic message, the method comprising: an act of receiving a body portion of an electronic message (abstract), the attachment comprising;

A coupling field indicating if the message is coupled to or decoupled from the electronic message and data field storing attachment data (col 7, lines 4-11);

an act of receiving an attachment associated with the electronic message; an act of receiving a delete command requesting deletion of the electronic message (abstract; col 6, lines 1-67);

an act of deleting the electronic message in accordance with the received delete command; and an act of automatically referring to the coupling field of the attachment to determine if the attachment data is to be deleted along with the electronic message in response to receiving the delete command (col 7, lines 4-11 and col 11, lines 44-53).

As to claim 2, Ogilvie teaches the method as recited in claim 1, wherein the act of receiving a body portion of an electronic message comprises an act of receiving a body portion of an electronic message wherein the body portion is included in an electronic message selected from among an electronic mail message, an instant message, a fax message, a news group posting, a voice message, and a blog entry (col 2, lines 33-65).

As to claim 3, Ogilvie teaches the method as recited in claim 1, wherein the act of receiving a body portion of an electronic message comprises an act of receiving a body portion of an electronic message, the electronic message being defined in accordance with one or more extension schemas (col 2, lines 33-65).

As to claim 4, Ogilvie teaches the method as recited in claim 1, wherein the act of receiving an attachment associated with the electronic message comprises an act of receiving an attachment that was included in the electronic message (col 7, lines 4-11 and col 11, lines 44-53).

As to claim 5, Ogilvie teaches the method as recited in claim 1, wherein the act of receiving an attachment associated with the electronic message comprises an act of receiving an attachment that includes an attachment metadata field, the attachment metadata field storing message related data associated with the electronic message such that if the electronic message is deleted message related data associated the electronic message can nonetheless be returned in response to a query (col 7, lines 4-11 and col 11, lines 44-53).

As to claim 6, Ogilvie teaches the method as recited in claim 1, wherein the act of receiving an attachment associated with the electronic message comprises an act of receiving an attachment that includes an IsPinned field, the value stored in the IsPinned field indicating if the attachment is coupled to the electronic message (col 7, lines 4-11 and col 11, lines 44-53).

As to claim 7, Ogilvie teaches the method as recited in claim 1, further comprising: an act of storing the electronic message and the body portion in a message silo of a database, the electronic message and body portion being stored along with one or more other message items defined in accordance with a message schema; an act of storing the attachment in a silo of the database; and an act of maintaining a link between the attachment and the electronic message (col 7, lines 4-11 and col 11, lines 44-53).

As to claim 8, Ogilvie teaches the method as recited in claim 1, wherein the act of receiving a delete command requesting deletion of the electronic message comprises an act of receiving a delete command that originated at a user message application (col 8, lines 42-60).

As to claim 9, Ogilvie teaches the method as recited in claim 1, wherein the act of deleting the electronic message in accordance with the received delete command comprises an act of deleting the electronic message and the body portion from a message silo of a database (col 6, lines 1-67).

As to claim 10, Ogilvie teaches the method as recited in claim 1, wherein that act of referring to a data field of the attachment to determine if the

Art Unit: 2155

attachment is to be deleted comprises an act of referring to the value of an IsPinned field to determine if the attachment is coupled to the electronic message (col 7, lines 4-11 and col 11, lines 44-53).

As to claim 11, Ogilvie teaches the method as recited in claim 1, wherein the act of referring to an act of referring to a data field of the attachment to determine if the attachment is to be deleted comprises an act of determining that the attachment is not to be deleted (col 7, lines 4-11 and col 11, lines 44-53).

As to claim 12, Ogilvie teaches the method as recited in claim 1, wherein the act of referring to an act of referring to a data field of the attachment to determine if the attachment is to be deleted comprises an act of determining that the attachment is to be deleted (col 7, lines 4-11 and col 11, lines 44-53).

As to claim 13, Ogilvie teaches the method as recited in claim 1, further comprising: an act of deleting the attachment from a silo of a database (col 7, lines 4-11 and col 11, lines 44-53).

### ***Response to Arguments***

11. Applicant's arguments filed have been fully considered but they are not persuasive. Specifically, the applicant argues that the amendments to the claims overcome all previous rejections.

12. In response, the examiner notes that due to the newly added limitations, the scope of the claim can not be properly determined. The introduction of a message (which may or may not be separate from the electronic message) is improperly done, please refer to the rejection above. Furthermore, the examiner



Art Unit: 2155

has better explained the rejections under 35 USC 101 to clarify the deficiencies in the claim language.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asad M. Nawaz whose telephone number is (571) 272-3988. The examiner can normally be reached on M-F 8-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax

Art Unit: 2155

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMN



SALEH NAJJAR  
SUPERVISORY PATENT EXAMINER